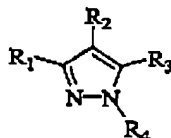


10. (Amended) The compound of claim 1, wherein at least one of [R1]  $R_1$  and [R3]  $R_3$  is substituted with at least one hydroxy or thio group.

11. (Amended) The compound of claim 1, wherein at least one of [R1]  $R_1$  and [R3]  $R_3$  is substituted with a substituent selected from the group consisting of halogen, loweralkyl, haloloweralkyl, loweralkyloxy, haloloweralkyloxy, carboxy, loweralkyloxycarbonyl, aryloxycarbonyl, (cycloloweralkyl) oxycarbonyl, aralkyloxycarbonyl, heteroaryloxycarbonyl, heteroaralkyloxycarbonyl, (heterocycloloweralkyl) oxycarbonyl, loweralkylsulfinyl, loweralkylsulfinyl, loweralkylthio, arylthio, loweralkylcarbonyloxy, arylcarbonyloxy, aralkylcarbonyloxy, heteroarylcarbonyloxy, heteroaralkylcarbonyloxy, (cycloloweralkyl) carbonyloxy, (heterocycloloweralkyl) carbonyloxy, aminocarbonyl, loweralkylaminocarbonyl, arylaminocarbonyl, aralkylaminocarbonyl, heteroarylaminocarbonyl, and heteroaralkylaminocarbonyl.

#### REMARKS

Claims 1-7 and 10-12 are pending in the application. Claim 1, 2 and 3 have been amended to further clarify the invention. Specifically claim 1 has been amended to specify that the claimed compounds are of the following formula:



Claim 1 has also been amended to specify that  $R_1$  is optionally substituted *para*-hydroxyphenyl and that  $R_2$  is an optionally substituted loweralkyl. Claims 2 and 3 have been amended and claims 8 and 9 have been canceled to reflect these changes. Support for these amendments may be found in former claims 1, 2, 3, 4 and 8 and throughout the specification including at col. 33 (scheme 9) and in numerous examples found at col. 41, line 53 to col. 81, line 60. Claim 5 has been amended to be rewritten in independent form by incorporating the limitations of claim 1. Support for this amendment may be found in former claims 1 and 5. Claims 3, 7, 10 and 11 have

been amended to correct typographical errors. No new matter has been added by any of these amendments.

*Rejections Under 35 U.S.C. § 112*

Claims 5-11 were rejected under 35 U.S.C. § 112 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically claims 5-7, 10 and 11 were rejected for lacking antecedent basis from claim 1. Applicants have amended claim 5 to independent form by incorporating the limitations of claim 1. Applicants believe that this amendment obviates the rejection of claim 5 as well as of claims 6 and 7 which depend from claim 5.

Applicants respectfully traverse the rejection with respect to claims 10 and 11. Amended claim 1 recites that  $R_1$  is optionally substituted *para*-hydroxyphenyl and  $R_3$  is an optionally substituted hydroxyaryl or alkoxyaryl group. Claims 10 and 11 recite substituents on the  $R_1$  and/or  $R_3$  groups. Thus, Applicants respectfully submit that claims 10 and 11 have antecedent basis in claim 1.

Claims 7-11 were rejected for containing typographical errors. As noted above, applicants have canceled 8 and 9. Applicants have amended claims 7, 10 and 11 claims to correct the typographical errors.

Thus, Applicants respectfully request that the Examiner withdraw these 35 U.S.C. § 112 rejections.

*Provisional Double Patenting Rejection*

Claims 1-4 and 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 5, 6, 10, 11, 13 and 54 of copending application No. 10/461,914.

Applicants have canceled claims 1-3, 5, 6, 10, 11, 13 and 54 from copending application No. 10/461,914 as being drawn to a non-elected invention. Accordingly, Applicants request that the Examiner withdraw the provisional double patenting rejection.

*Rejection under 35 U.S.C. § 103*

Claims 1, 3, 4, 9, 11 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainer US Patent 4,325,962 ("Rainer"). The Examiner contends that Rainer generically describes the instant claimed compounds and that one of skill in the art would be motivated to make the claimed compounds from the expectation that the structurally similar compounds would possess similar activity (e.g., as an anti-inflammatory agent).

The present invention relates to pyrazole compounds possessing unexpected and surprising activity in modulating estrogen receptor activity. As discussed above, the claims have been amended to specify that the claimed compounds contain a *para*-hydroxyphenyl group at the 3-position of the pyrazole ring.

Rainer describes a large genus of pyrazole compounds that possess anti-inflammatory activity. Rainer does not generically describe the compounds recited in the amended claims. Specifically, Rainer does not teach or suggest compounds substituted with a hydroxyphenyl group on the pyrazole ring. Further, one of skill in the art would have no reason to expect that the compounds of the present invention would possess similar activity to those taught in Rainer, especially considering the unpredictable nature of the art. Given the large scope of the genus disclosed in Rainer, the unpredictable nature of the art, and the structural dissimilarity between the claimed compounds and Rainer, one of skill in the art would not be motivated to modify Rainer to make the claimed compounds.

Further, Applicants' invention has unexpected and surprising properties, specifically modulating estrogen receptor activity. Nothing in Rainer teaches or suggests that the claimed compounds would possess estrogen receptor modulating activity. The structural nonobviousness and the surprising and unexpected properties of the claimed compounds render the present invention patentable over the cited art.


*Conclusion*

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at (510) 843-6200. If any further fees are due in connection with the filing of this

amendment, the Commissioner is authorized to charge such fees to Deposit Account 500388 (Order No. CHIRP018R).

Please direct all correspondence to the correspondence address indicated below with Customer Number 27476.

Respectfully submitted,  
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